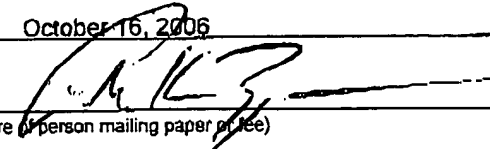


I hereby certify that this correspondence is being filed by facsimile and addressed to MS: Appeal Related Matters, Board of Patent Appeals and Interferences, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Date: October 16, 2006


(Signature of person mailing paper of fee)

PATENT

Paper No.

File: Kor1-CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|----------------|---|---------------------------|
| Inventor | : | Charles Kormanik, Jr. |
| Serial No. | : | 08/802,472 |
| Appeal No. | : | 2006-1451 |
| Filed | : | February 18, 1997 |
| For | : | THEMATIC PACKAGING SYSTEM |
| Group Art Unit | : | 3208 |
| Examiner | : | Luby, M. |

MS: Appeal Related Matters
Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

SIR:

Please enter the following enclosed documents in the above-identified patent application.

1. Request for Rehearing.

Applicant claims small entity status. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Ser. No. 08/802,472
Appeal No. 2006-1451
Art Unit: 3208
Atty Ref. Kor1-CIP

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



Peter K. Trzyzna
(Reg. No. 32,601)

Date: October 16, 2006

P.O. Box 7131
Chicago, IL 60680-7131
(312) 240-0824

TRANSMISSION VERIFICATION REPORT

TIME : 10/16/2006 13:28
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SER.# : BROE6F989146

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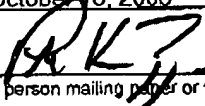
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PATENT

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| Group Art Unit | : | 3208 |
| Examiner | : | Luby, M. |

MS: Appeal Related Matters
Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING TO Sec. 37 C.F.R. 41.52

S I R:

Applicant respectfully requests a rehearing on the record to address new grounds of rejection and, respectfully, errors pertaining to the cited art as applied in the Decision. More particularly, the points believed to be misinterpreted or overlooked pertain to the new grounds of rejection, and particularly claim-distinctions over the cited art.

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Appeal No. 2006-1451
Art Unit: 3208
Atty Ref. Kor1-CIP

I. REMARKS

There is good cause for having not previously presented the argument set forth below, namely the citing of new grounds of rejection in the Decision and that which is set forth below.

A. New Ground of Rejection: Sec. 112 Rejection, Second Paragraph

In the Decision, a new ground of rejection has been entered. Claims 5, 17-24, 27-31, and 49-58 have been rejected pursuant to 35 U.S.C. Sec. 112, second paragraph. The Decision contends that these claims fail to point out and distinctly claim the subject matter which the applicant regards as his invention. The Decision points to visually suggestive, associated with, and recognizable claim language.

The suggestive standard, i.e., the shape of the package visually suggestive of an activity..., is the basis for granting federal rights, namely the rights conveyed by a federal trademark registration. Applicant pointed out this meaning in the specification at page 13 and elsewhere, e.g., distinguishing from a suggestive from generic shape, mentioning a symbol or icon, etc.: The specification and claims use the language of trademark law. The notion of premising a grant of a federal right on the basis of a shape that is visually suggestive of an activity is highly defined in almost countless decisions in the U.S. and internationally, see, e.g., the TMEP Sec. 1200 et. seq. and citations therein. It is not "totally subjective to each individual obviating any possibility of pointing out the scope of the claims" as stated in the Decision at page 21; nor can it be said that this language provides "no objective standards," nor can it be said that this is an "inconceivability standard," as per page 23; nor "no objective standard"; nor that "the standards of recognizability and visual suggestion are no more objective than a standard for aesthetic pleasure", at page at page 25; nor "the test the appellant has applied in the prosecution history, that of inconceivability, is highly subjective to personal levels of

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conception" at page 24 - as this standard is applied by the U.S. Patent and Trademark Office in granting the rights that come with a federal trademark registration.

The Sec. 112 ground of rejection has, more or less, previously been raised by the Examiner. Applicant pointed to TMEP section 1209(a) in Applicant's filing of September 15, 2003, and, during the noted Interview, Applicant requested that deference and consideration be given to the use of the term by the other branch of the Patent and Trademark Office. Though the Examiner contended in the office action of 12/02/03 that "patent applications and trademark applications are governed by separate laws" (page 10), the rejection was not pursued.

The added terms of recognizable as regards an icon or symbol confine the scope of the shape, and are also consistent with trademark usage of an icon or symbol being suggestive.

Prohibiting the use of the trademark law standard in a patent claim also essentially precludes the possibility of claiming the particular type of invention at issue, i.e., thematic packaging. Applicant must be allowed to claim the theme in thematic packaging, and as to shapes, the vocabulary of trademark law is appropriate, if not necessary.

In sum, the newly rejected claims do not fail to particularly claim and distinctly point out the subject matter, but rather, comply with Sec. 112 by using the language of trademark law, which is the law used by the U.S. Patent and Trademark Office in granting a trademark registration.

B. Applicant is Entitled to a Consistent Claim Interpretation

The Decision contends "that multiple theories cannot be the basis for negating the rejection" and that "multiple theories do not negate novelty but rather provide additional support for the argument." See Decision at page 6.

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It is respectfully contended that Applicant is entitled to a *consistent* claim construction, and multiple theories where none accounts for all claim requirements without inconsistency is not permissible. Only when a claim is properly understood can a determination be made whether the claim "reads on" an accused device or method, or whether the prior art anticipates and/or renders obvious the claimed invention. Applicant is entitled to a consistent claim construction pursuant to 35 U.S.C. Sec. 102, 103, and/or 132.

Applicant's brief pointed out that anticipation/obviousness had not been properly shown because no *consistent* claim construction could account for all claim requirements. (As to the theories, see pages 16-17; applied to the claim requirements of claim 5, for example, continuing on to page 20.) The Decision at page 6, like the rejection, does not provide a consistent claim construction to which Applicant is entitled as a prerequisite to a rejection.

Applicant requests the consistent claim construction to which Applicant is entitled.

C. Applicant Has Not Received a Proper Claim Interpretation

The Decision states that "none of the independent claims constrain the limits of visual suggestion or usage" at page 5.

It is respectfully submitted that this claim interpretation ignores claim limitations, and Applicant has not received a proper and consistent claim construction.

Consider for example, the Decision contends "claim 5 imposes no limitation requiring a specific activity to be a sport" at page 6. This argument misses the point of the Brief: "sport" was alleged by the Examiner in an inconsistent claim construction. The same is true regarding the Decision concerning Applicant's 1-5 arguments at Page 4. No consistent claim construction has been applied to the cited art, and thus the rejection is improper under the aforesaid statutes.

All limitations must be considered, In re Fine. See also the Brief. One, but not the only, example, is the claim 5 requirement of in which the article is used during the activity, after

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removal from the package is being given improper or lack of interpretation, especially with respect to the above-mentioned suggestive standard.

The Brief and Reply are directed to a proper and consistent application of all claim requirements. Applicant requests a proper and consistent application of all claim requirements to the cited art.

D. New Ground of Rejection: Sec. 112 Rejection, First Paragraph

In the Decision, a new ground of rejection has been entered. Claims 18-19 have been rejected pursuant to 35 U.S.C. Sec. 112, first paragraph. The Decision contends that claims 18-19 are not commensurate with the written description and enablement..." at page 21.

The specification teaches, at page 15, lines 28-31:

"a preferred embodiment is to locate the thematically-shaped packaging within other suggestive packaging-preferably suggestive by virtue of its shape too."

Claims 18-19 are adequately supported by a written and enabling description in the specification.

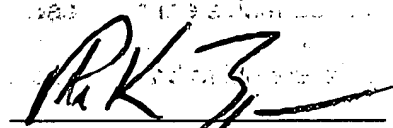
Ser. No. 08/802,472
Appeal No. 2006-1451
Art Unit: 3208
Atty Ref. Kor1-CIP

II. Conclusion

In conclusion, Applicant requests withdrawal of the Sec. 112, second paragraph, new ground of rejection because the claims use the standard applied by the US Patent and Trademark Office in granting trademark registrations and the federal rights therewith, a standard that does not violate of Sec. 112, second paragraph. Applicant is entitled to a consistent claim construction and, for an art rejection, a proper application of that claim construction to the cited art, i.e., consideration of all claim limitations. Based on the evidence of record, considered in accordance with the foregoing statutory requirements and evidence of record, the claims should be allowed over the art cited in the rejections for the reasons cited in the Brief and Reply Brief. Applicant further requests withdrawal of the Sec. 112, first paragraph, new ground of rejection because the specification provides a written and enabling description of the claimed invention.

APPLICANT CLAIMS SMALL ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Respectfully submitted,



Date: October 16, 2006

Peter K. Trzyzna
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To: Tina Lee

Re: 2006-1451 Lost Papers

Firm: Board of Patent Appeals and Interferences

Date / Time: December 13, 2006

Street Address: U.S. Patent and Trademark Office

Phone: (571) 272-4627

City, State Zip: Alexandria, VA 22313-1450

Fax: (571) 273-0299

cc: Lezlie Morris (571) 273-6651

No. of Pages: 10 (including cover)

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Message:

Dear Ms. Lee:

Enclosed please find a copy of the Request for Rehearing filed in the above-identified appeal on October 16, 2006. The Request was timely filed by fax to the number listed in the Decision, as evidenced by the enclosed fax receipt.

Please advise as to how best to proceed.

Very truly yours,

Peter K. Trzyna